

REMARKS

Claims 2-16, 34-41, and 43-49 are pending and at issue in the above identified patent application. Of the claims at issue, claims 15, 40, and 48 are independent. In view of the foregoing amendments and the following remarks, reconsideration of the application is respectfully requested. In canceling the claims, the applicants do not intend to abandon the scope of any of the canceled claims, and may pursue the claims in a continuing application. In particular, the claims have been canceled in order to further the prosecution of the present application, and the applicants do not admit that any of the canceled claims are unpatentable over the cited art.

Information Disclosure Statement

The applicants resubmitted an Information Disclosure Statement on August 11, 2005, including copies of both the International Search Report and the Written Opinion. The applicants request that the examiner consider the submitted art.

Drawing Objections

The applicants have canceled claims 17 and 27 without prejudice. Accordingly, the foregoing amendment should eliminate any objection to the drawings that may have been proper.

The Rejections under 35 U.S.C. § 103

Claims 15, 16, 40, 41, 48, and 49 were rejected as being unpatentable over Ganzinotti (US 3,341,974) in view Long (US 6,098,992). However, neither Ganzinotti nor Long, either alone or in combination, discloses or suggests thermal insulation disposed inside at least a portion of an elongated air passageway. Accordingly, it is

respectfully submitted that all claims are allowable over these patents for the reasons set forth below.

Independent claims 15, 40, and 48 are generally directed to a door having an insulated inflatable seal. In particular, the claims recite, *inter alia*, a door having an inflatable seal between a door member and a door panel, wherein the inflatable seal defines an air inlet, an air outlet, and an elongated air passageway between the inlet and outlet. More particularly, the inflatable seal includes thermal insulation, disposed inside at least a portion of the elongated passageway. Neither Ganzinotti nor Long discloses thermal insulation disposed inside the elongated passageway.

Rather, Ganzinotti is directed to a sealing joint for a refrigerator door heated to prevent the formation of frost. Specifically, Ganzinotti discloses the circulation of fluid in a hollow sealing joint to prevent the deposits of frost on its surface and on the areas adjacent the door and the door frame. Ganzinotti does not, however, disclose or suggest thermal insulation disposed within the sealing joint. The examiner acknowledges that Ganzinotti fails to teach a seal provided with thermal insulation.

In view of the admitted deficiency of Ganzinotti, the examiner turns to Long to allegedly cure this deficiency. In particular, the examiner alleges that Long discloses “a heated inflatable seal having thermal insulation.” Further, the examiner alleges that it would have been obvious to one of ordinary skill in the art “to provide the seal of Ganzinotti with thermal insulation as taught by Long.” (Office action pages 4,5).

In contrast, however, Long does not teach or suggest thermal insulation disposed within the passageway of an inflatable seal. Rather, Long teaches a collapsible seal attached to a vacuum source including a heating element (57) disposed upon a reflective

shield (56) and connected to an electrical wire (58). (See col. 5, lines 3-15, and FIG. 5).

These three elements, however, are conductors of thermal energy, not thermal insulation as claimed. Furthermore, the only disclosure regarding insulators in Long pertains to the point of attachment of the seal members to the surrounding structure, but these insulators are *electrical*, as opposed to *thermal* insulators. (See FIG. 13). Accordingly, despite the allegations in the Office action, Long fails to teach or suggest thermal insulation disposed within a passageway of an inflatable seal.

Therefore due to the deficiencies in both Ganzinotti and Long, it follows that no combination of Ganzinotti and Long can render obvious claims 15, 40, 48, or any claims dependent thereon. In particular, because neither reference discloses thermal insulation disposed within a passageway of an inflatable seal, no combination of Ganzinotti and Long can result in the claimed system. Accordingly, it is respectfully submitted that for at least these reasons, claims 15, 40, and 48 and all claims dependent thereon are in condition for allowance.

Moreover, it is well established that the mere fact that references can be combined is not sufficient to establish a *prima facie* case of obviousness. See Section 2143.01 of the M.P.E.P., which states: “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)” (emphasis original).

In order to establish a *prima facie* case of obviousness, there must be actual evidence of a suggestion to modify a prior art reference or to combine two prior art references, and the suggestion to combine or modify the prior art must be clear and

particular. See, for example, In re Dembiczak, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir.

1999), where the Court of Appeals for the Federal Circuit stated:

The range of sources available, however, does not diminish the requirement for **actual evidence**. That is, the showing must be **clear and** particular. Broad conclusory statements regarding the teaching of multiple references, standing alone, are **not ‘evidence.’** (emphasis added, citations omitted).

The suggestion to combine references must be from the prior art, not Applicants’ disclosure. See Section 2143 of the M.P.E.P., which states: “The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).”

The rejections of the claims are based on the allegation that one of ordinary skill in the art at the time of the invention would seek to provide the seal of Ganzinotti with thermal insulation as taught by Long, since thermal insulation provides less heat transfer and thereby increases the efficiency of the system. (Office action, p. 4-5).

However, the combination proposed in the Office action is predicated on Long actually teaching thermal insulation (which it does not), and that one of ordinary skill in the art of inflatable seals would look to collapsible seals or that one of ordinary skill in the art would blindly look to increase thermal efficiency, without regard to any drawbacks associated therewith.

Specifically, as noted above, Long does not teach or suggest thermal insulation, but rather, teaches a heating element within the seal. Moreover, Ganzinatti specifically rejects heating elements of the type described in Long stating that “formation of frost is often prevented by arranging an electrical heating resistance element near the joint.

Whilst being quite satisfactory, this solution is costly and it does not generally allow the joint to be uniformly reheated.” (Col. 1, line 30).

Also, as overlooked by the examiner, the operating principles associated with collapsible seals is significantly different than those of inflatable seals. For example, Long teaches the use of a vacuum to collapse a seal in order to prevent frost. This action entails breaking contact between the seal and the contact surface. In contrast Ganzinotti teaches the circulation of air in an inflatable system, designed to maintain seal contact. Additionally one would necessarily look to combine Ganzinotti with the teachings of Long because to do so would add thickness and/or rigidity to the inflatable seal which may have unintended and detrimental impact on the inflatable seal efficiency. Accordingly, despite the assertions by the examiner, there is no evidence that one of ordinary skill in the art would have been motivated to look to the collapsible seal of Long to modify the teachings of Ganzinotti for any reason.

Therefore, because there is no suggestion in the prior art for the desirability to combine the references, it is respectfully submitted that a *prima facie* case of obviousness, has not been established. Thus, for at least these reasons, the claims are in condition for allowance.

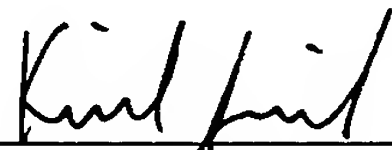
Conclusion

Reconsideration of the application and allowance thereof are respectfully requested. If there is any matter that the examiner would like to discuss, the examiner is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,

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